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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/510,684	10/08/2004	Noriko Endou	Q83593	3894

23373 7590 09/11/2007
SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER

PENG, KUO LIANG

ART UNIT	PAPER NUMBER
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1712

MAIL DATE	DELIVERY MODE
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09/11/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/510,684	Applicant(s) ENDOU ET AL.	
	Examiner Kuo-Liang Peng	Art Unit 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/13/07 RCE.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,7-14 and 19-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,7-14 and 19-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 13, 2007 has been entered. Claims 2, 6 and 15-18 are deleted. Claims 1 and 7 are amended. Claims 22-35 are added. Now, Claims 1, 3-5, 7-14 and 19-35 are pending.

2. Claim objection(s) (except Claim 10) in the previous Office Action (Paper No. 021707) is/are removed.

3. Double patenting rejection(s) in the previous Office Action (Paper No. 021707) is/are removed.

4. Claim rejection(s) under 35 USC 102 and 103 in paragraphs 6-8 of the previous Office Action (Paper No. 021707) is/are removed.

None of the Nakagawa (US 6 274 688), JP906 (JP 56-104906) and JP998 (JP 2000-086998) teaches or fairly suggests the claimed hydrocarbyloxysilane of formula (I) or formula (II).

5. The text of those sections of Title 35, U.S. code not included in this action can be found in prior Office Action(s).

Claim Rejections - 35 USC § 112

6. Claims 10 and 25-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 10 (line 2), “claim 2” causes confusion because a claim cannot depend on a canceled claim.

In Claim 25 (page 7, last three lines), it is not clear as to what “A¹”, “R¹”, “R²”, “R³” and “n” refer to.

In Claim 25 (page 8, lines 2-4), it is not clear as to what “A²”, “R⁴”, “R⁵”, “R⁶” and “m” refer to.

In Claim 31 (last line), it is not clear as to what “A_z⁴TiB_{4-z}²” refers to.

Claim Rejections - 35 USC § 103

7. Claims 1, 3-5, 7-14, 19-21, 24-28, 30-31 and 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haynes (EP 067 468) in view of Ishikawa (US 6 191 247).

The following column and line numbers of Haynes are based on its' US equivalent, US 4 379 891.

For Claims 1, 3-5, 7-12, 19-20, 25-28, 30-31 and 33-34, Haynes discloses a composition comprising a modified polymer derived by a process of treating a living polymer with a hydrocarbyloxysilane compound such as γ -glycidoxypentyltrimethoxysilane (GPTS) according to the instant claims. Silica can be used. (col. 2, line 8 to col. 5, line 13 and Illustrative Embodiments) Haynes is silent on the use of a condensation accelerator. However, Ishikawa teaches the use of a tin or titanium condensation accelerator to facilitate the reaction between a hydrocarbyloxysilane compound and the silanol groups on the silica surface. (col. 12, lines 13-24) Therefore, it would have been obvious to one of ordinary skilled in the art at the time of the invention was made to incorporate Haynes' condensation accelerator into Haynes' composition. Since Haynes' process of compounding the composition does particularly exclude any moisture. As such, the condensation is conventionally performed in atmosphere, i.e., the presence of moisture. Haynes

further discloses a rubber composition. (col. 5, lines 5-59) For Claims 13-14 and 24, Haynes is silent on the specific Mooney viscosity that is closely related to the weight average molecular weight in the claimed invention. However, Haynes teaches the use of the polymer as a material for footwear, etc. (col. 5, lines 5-28) The viscosity of the material can affect the processibility of the material. As such, the viscosity of the material is a Result-Effective variable. Therefore, it would have been obvious to one of ordinary skilled in the art at the time of the invention was made to utilize a polymer with whatever viscosity/weight average molecular weight through routine experimentation in order to obtain a material having a desired processibility. Especially, Applicants do not show the criticality of the viscosity/weight average molecular weight. See MPEP 2144.05 (II). For Claims 21 and 35, Haynes teaches the use of the composition for making shoe tread. As such, it would have been obvious to one of ordinary skilled in the art at the time of the invention was made to utilize the composition for tires because both the shoes and tires are brought in contact with the road surface.

For Applicants' argument (Remarks, page 16, 2nd and 4th paragraphs), Applicants are advised that Ishikawa' silanol condensation catalyst is blended in a dry mixing stage for the rubber composition. As such, it is indeed added to the reaction system **after completion** thereof.

For Applicants' argument (Remarks, page 16, 3rd paragraph), the alleged properties are not claimed. Furthermore, Applicants are reminded that mere recognition of latent properties in the prior art does not render nonobvious an otherwise known invention. *In re Wiseman*, 596 F.2d 1019, 201 USPQ 658 (CCPA 1979)

8. Claims 23 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haynes in view of Ishikawa as applied to claims 1, 3-5, 7-14, 19-21, 24-28, 30-31 and 33-35 above, and further in view of Materne (US 6 403 693).

The difference between Haynes in view of Ishikawa and the present invention is the requirement of the claimed condensation accelerator. However, Ishikawa teaches the use of dibutyl tin dilaurate as a condensation catalyst. (col. 12, lines 25-34) Furthermore, Materne teaches the equivalency and interchangeability of dibutyl tin dilaurate and bis(2-ethylhexanoate) as a condensation catalyst. As such, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize bis(2-ethylhexanoate) as a condensation catalyst in Haynes' composition with expected success. See MPEP 2144.06.

9. Claims 1, 3-5, 7-14, 19-21, 24-28, 30-31 and 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ozawa (WO 01/34658) optionally in view of Ishikawa (US 6 191 247).

The following column and line numbers of Ozawa are based on its' US equivalent, US 6 992 147.

Ozawa discloses a composition comprising a modified polymer derived by a process of treating a pseudo-living polymer with a hydrocarbyloxysilane compound according to the instant claims. (col. 5, line 38 to col. 11, lines 24) The relative amount of the hydrocarbyloxysilane to the lanthanide is described in col. 11, lines 20-24. Fillers such as silica can be used. (col. 13, lines 3-44) Ozawa further teaches the condensation of the modified polymer. (col. 12, lines 18-38) Ozawa also teaches the use of a condensation accelerator such as diorganotin dicarboxylates for oligomerizing the hydrocarbyloxysilane compounds. (col. 6, lines 40-59) As such, it would have been obvious to one of ordinary skilled in the art at the time of the invention was made to utilize diorganotin dicarboxylates as condensation accelerator for condensing the modified polymer because both oligomerization of the hydrocarbyloxysilane compounds and condensation of the modified polymer involves the same reaction. **Alternatively**, Ozawa teaches that a coupling agent besides the aforementioned modified polymer for treating silica

surface can be used. (col. 2, lines 1-4 and col. 13, lines 45-61) Ozawa is silent on the specific use of a condensation accelerator for the purpose of facilitating the reaction between the hydrocarbyloxysilane and the silanol groups on the silica surface. However, Ishikawa teaches the use of a tin or titanium condensation accelerator to facilitate the reaction between a hydrocarbyloxysilane compound and the silanol groups on the silica surface. (col. 12, lines 13-24) Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate Ishikawa's condensation accelerator into Ozawa's composition. Since Ozawa's process of compounding the composition does particularly exclude any moisture. As such, the condensation is conventionally performed in atmosphere, i.e., the presence of moisture. Ozawa further discloses a rubber composition for making tires. (col. 12, line 39 to col. 14, line 39) The Mooney viscosity of the composition is exemplified in Examples. The weight average molecular weights of the modified polymers are illustrated in Table I.

For Applicants' argument (Remarks, page 16, 2nd and 4th paragraphs), Applicants are advised that Ishikawa's silanol condensation catalyst is blended in a dry mixing stage for the rubber composition. As such, it is indeed added to the reaction system **after completion** thereof.

For Applicants' argument (Remarks, page 16, 3rd paragraph), the alleged properties are not claimed. Furthermore, Applicants are reminded that mere recognition of latent properties in the prior art does not render nonobvious an otherwise known invention. *In re Wiseman*, 596 F.2d 1019, 201 USPQ 658 (CCPA 1979)

10. Claims 23 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ozawa, optionally in view of Ishikawa as applied to claims 1, 3-5, 7-14, 19-21, 24-28, 30-31 and 33-35 above, and further in view of Materne.

The difference between Ozawa, optionally in view of Ishikawa, and the present invention is the requirement of the claimed condensation accelerator. However, Ishikawa teaches the use of dibutyl tin dilaurate as a condensation catalyst. (col. 12, lines 25-34) Furthermore, Materne teaches the equivalency and interchangeability of dibutyl tin dilaurate and bis(2-ethylhexanoate) as a condensation catalyst. As such, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize bis(2-ethylhexanoate) as a condensation catalyst in Ozawa's composition with expected success. See MPEP 2144.06.

11. Claims 1, 3-5, 7-14, 19-22, 24-31 and 33-35 are rejected under 35

U.S.C. 103(a) as being unpatentable over Takeishi908 (US 6 228 908) in view of Ishikawa (US 6 191 247).

Takeishi908 discloses a composition comprising a modified polymer derived by a process of treating a living polymer with a hydrocarbyloxysilane compound according to the instant claims. (col. 3, line 58 to col. 9, line 3 and Examples) Fillers such as silica can be used. The silica can be surface treated with hydrocarbyloxysilane compounds. (col. 10, line 37 to col. 11, line 64) Takeishi is silent on the specific use of a condensation accelerator. However, Ishikawa teaches the use of a tin or titanium condensation accelerator to facilitate the reaction between a hydrocarbyloxysilane compound and the silanol groups on the silica surface. (col. 12, lines 13-24) Therefore, it would have been obvious to one of ordinary skilled in the art at the time of the invention was made to incorporate Ishikawa' condensation accelerator into Takeishi908' composition. Since Takeshi908' process of compounding the composition does particularly exclude any moisture. As such, the condensation is conventionally performed in atmosphere, i.e., the presence of moisture. Takeishi908 further discloses a rubber composition for making tires. (col. 14, line 55 to col. 15, line 2) The Mooney viscosity of the composition is exemplified in Examples. Takeishi908 is silent on

the specific weight average molecular weight set forth in Claim 24. However, Takeishi908 teaches that the molecular weight is important for workability. (col. 2, lines 34-40) As such, the molecular weight is a Result-Effective variable. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize a polymer with whatever weight average molecular weight through routine experimentation in order to afford a polymer composition having desired workability. Especially, Applicants do not show the criticality of the molecular weight. See MPEP 2144.05 (II). Takeishi908 further teaches the use of randomizer in the anionic polymerization. (col. 5, line 58 to col. 6, line 7)

For Applicants' argument (Remarks, page 16, 2nd and 4th paragraphs), Applicants are advised that Ishikawa' silanol condensation catalyst is blended in a dry mixing stage for the rubber composition. As such, it is indeed added to the reaction system **after completion** thereof.

For Applicants' argument (Remarks, page 16, 3rd paragraph), the alleged properties are not claimed. Furthermore, Applicants are reminded that mere recognition of latent properties in the prior art does not render nonobvious an otherwise known invention. *In re Wiseman*, 596 F.2d 1019, 201 USPQ 658 (CCPA 1979)

12. Claims 23 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takeishi908 in view of Ishikawa as applied to claims 1, 3-5, 7-14, 19-22, 24-31 and 33-35 above, and further in view of Materne.

The difference between Takeishi908 in view of Ishikawa, and the present invention is the requirement of the claimed condensation accelerator. However, Ishikawa teaches the use of dibutyl tin dilaurate as a condensation catalyst. (col. 12, lines 25-34) Furthermore, Materne teaches the equivalency and interchangeability of dibutyl tin dilaurate and bis(2-ethylhexanoate) as a condensation catalyst. As such, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize bis(2-ethylhexanoate) as a condensation catalyst in Takeishi908's composition with expected success. See MPEP 2144.06.

13. Claims 1, 3-5, 7-14, 19-22, 24-31 and 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hogan (US 6 573 412) in view of Ishikawa (US 6 191 247).

Hogan discloses a composition comprising a modified polymer derived by a process of treating a living polymer with a hydrocarbyloxysilane compound

according to the instant claims. (col. 4, line 66 to col. 14, line 21 and Examples)

Fillers such as silica, carbon black, etc. can be used. The silica can be surface treated with the modified polymer. (col. 12, lines 7-58 and col. 14, line 23 to col. 15, line 18) Hogan is silent on the specific use of a condensation accelerator.

However, Ishikawa teaches the use of a tin or titanium condensation accelerator to facilitate the reaction between a hydrocarbyloxysilane compound and the silanol groups on the silica surface. (col. 12, lines 13-24) Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate Ishikawa's condensation accelerator into Hogan's composition. Since Hogan's process of compounding the composition does particularly exclude any moisture. As such, the condensation is conventionally performed in atmosphere, i.e., the presence of moisture. Hogan further discloses a rubber composition for making tires. (col. 4, lines 6-21) The Mooney viscosity of the composition is exemplified in Examples. Hogan is silent on the claimed weight average molecular weight set forth in Claim 24. However, Hogan teaches that the molecular weight is important for processibility. (col. 3, lines 11-28) As such, the molecular weight is a Result-Effective variable. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize a polymer with whatever weight average molecular weight through routine experimentation in

order to afford a polymer composition having desired processibility. Especially, Applicants do not show the criticality of the molecular weight. See MPEP 2144.05 (II). Hogan further teaches the use of randomizer in the anionic polymerization. (col. 7, lines 14-27)

For Applicants' argument (Remarks, page 16, 2nd and 4th paragraphs), Applicants are advised that Ishikawa' silanol condensation catalyst is blended in a dry mixing stage for the rubber composition. As such, it is indeed added to the reaction system **after completion** thereof.

For Applicants' argument (Remarks, page 16, 3rd paragraph), the alleged properties are not claimed. Furthermore, Applicants are reminded that mere recognition of latent properties in the prior art does not render nonobvious an otherwise known invention. *In re Wiseman*, 596 F.2d 1019, 201 USPQ 658 (CCPA 1979)

14. Claims 23 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hogan in view of Ishikawa as applied to claims 1, 3-5, 7-14, 19-22, 24-31 and 33-35 above, and further in view of Materne.

The difference between Hogan in view of Ishikawa, and the present invention is the requirement of the claimed condensation accelerator. However,

Ishikawa teaches the use of dibutyl tin dilaurate as a condensation catalyst. (col. 12, lines 25-34) Furthermore, Materne teaches the equivalency and interchangeability of dibutyl tin dilaurate and bis(2-ethylhexanoate) as a condensation catalyst. As such, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize bis(2-ethylhexanoate) as a condensation catalyst in Hogan's composition with expected success. See MPEP 2144.06.

15. Claims 1, 3-5, 7-14, 19-22, 24-31 and 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morita (US 6 369 167) in view of Ishikawa.

Morita discloses a composition comprising a modified polymer derived by a process of treating a living polymer with a hydrocarbyloxysilane compound according to the instant claims. (col. 3, line 65 to col. 7, line 35 and Examples) Fillers such as silica, carbon black, etc. can be used. The silica can be surface treated with the modified polymer by the modified polymer and/or hydrocarbyloxysilane compounds. (col. 2, lines 1-8 and col. 7, lines 36 to col. 8, line 38) Morita is silent on the specific use of a condensation accelerator. However, Ishikawa teaches the use of a tin or titanium condensation accelerator to facilitate

the reaction between a hydrocarbyloxysilane compound and the silanol groups on the silica surface. (col. 12, lines 13-24) Therefore, it would have been obvious to one of ordinary skilled in the art at the time of the invention was made to incorporate Ishikawa' condensation accelerator into Morita' composition. Since Morita' process of compounding the composition does particularly exclude any moisture. As such, the condensation is conventionally performed in atmosphere, i.e., the presence of moisture. Morita further discloses a rubber composition for making tires. (col. 7, lines 24-35) The Mooney viscosity of the composition is exemplified in Examples. A randomizer can be used. (col. 4, line 57 to col. 5, line 13) Morita is silent on the weight average molecular weight of the polymer. However, the molecular weight is important for processibility. As such, the molecular weight is a Result-Effective variable. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize a polymer with whatever weight average molecular weight through routine experimentation in order to afford a polymer composition having desired processibility. Especially, Applicants do not show the criticality of the molecular weight. See MPEP 2144.05

For Applicants' argument (Remarks, page 16, 2nd and 4th paragraphs), Applicants are advised that Ishikawa' silanol condensation catalyst is blended in a

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dry mixing stage for the rubber composition. As such, it is indeed added to the reaction system **after completion** thereof.

For Applicants' argument (Remarks, page 16, 3rd paragraph), the alleged properties are not claimed. Furthermore, Applicants are reminded that mere recognition of latent properties in the prior art does not render nonobvious an otherwise known invention. *In re Wiseman*, 596 F.2d 1019, 201 USPQ 658 (CCPA 1979)

16. Claims 23 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morita in view of Ishikawa as applied to claims 1, 3-5, 7-14, 19-22, 24-31 and 33-35 above, and further in view of Materne.

The difference between Morita in view of Ishikawa, and the present invention is the requirement of the claimed condensation accelerator. However, Ishikawa teaches the use of dibutyl tin dilaurate as a condensation catalyst. (col. 12, lines 25-34) Furthermore, Materne teaches the equivalency and interchangeability of dibutyl tin dilaurate and bis(2-ethylhexanoate) as a condensation catalyst. As such, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize bis(2-ethylhexanoate) as a

condensation catalyst in Morita's composition with expected success. See MPEP 2144.06.

17. Claims 1, 3-5, 7-14 and 19-21, 22, are rejected under 35 U.S.C. 103(a) as being unpatentable over Takeichi295 (US 6 008 295) in view of Ishikawa (US 6 191 247).

Takeichi295 discloses a composition comprising a modified polymer derived by a process of treating a living polymer with a hydrocarbyloxysilane compound according to the instant claims. (col. 2, line 21 to col. 3, line 11, col. 4, line 14 to col. 8, line 55 and Examples) Fillers such as silica, carbon black, etc. can be used. The silica can be surface treated with the modified polymer by the modified polymer. (col. 11, lines 1-5) Takeichi295 is silent on the specific use of a condensation accelerator. However, Ishikawa teaches the use of a tin or titanium condensation accelerator to facilitate the reaction between a hydrocarbyloxysilane compound and the silanol groups on the silica surface. (col. 12, lines 13-24) Therefore, it would have been obvious to one of ordinary skilled in the art at the time of the invention was made to incorporate Ishikawa's condensation accelerator into Takeichi295's composition. Since Takeichi295's process of compounding the composition does particularly exclude any moisture. As such, the condensation is

conventionally performed in atmosphere, i.e., the presence of moisture.

Takeichi295 further discloses a rubber composition for making tires. (col. 11, lines 40-54) The Mooney viscosity of the composition is exemplified in Examples. A randomizer can be used. (col. 5, lines 43-59) Takeishi295 is silent on the specific weight average molecular weight set forth in Claim 24. However, Takeishi295 teaches that the molecular weight is important for workability. (col. 2, lines 21-27) As such, the molecular weight is a Result-Effective variable. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize a polymer with whatever weight average molecular weight through routine experimentation in order to afford a polymer composition having desired workability. Especially, Applicants do not show the criticality of the molecular weight. See MPEP 2144.05 (II).

For Applicants' argument (Remarks, page 16, 2nd and 4th paragraphs), Applicants are advised that Ishikawa' silanol condensation catalyst is blended in a dry mixing stage for the rubber composition. As such, it is indeed added to the reaction system **after completion** thereof.

For Applicants' argument (Remarks, page 16, 3rd paragraph), the alleged properties are not claimed. Furthermore, Applicants are reminded that mere recognition of latent properties in the prior art does not render nonobvious an

otherwise known invention. *In re Wiseman*, 596 F.2d 1019, 201 USPQ 658 (CCPA 1979)

18. Claims 23 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takechi295 in view of Ishikawa as applied to claims 1, 3-5, 7-14, 19-22, 24-31 and 33-35 above, and further in view of Materne.

The difference between Takeshi295 in view of Ishikawa, and the present invention is the requirement of the claimed condensation accelerator. However, Ishikawa teaches the use of dibutyl tin dilaurate as a condensation catalyst. (col. 12, lines 25-34) Furthermore, Materne teaches the equivalency and interchangeability of dibutyl tin dilaurate and bis(2-ethylhexanoate) as a condensation catalyst. As such, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize bis(2-ethylhexanoate) as a condensation catalyst in Takechi295's composition with expected success. See MPEP 2144.06.

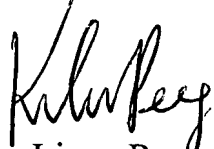
19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is

(571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp
September 5, 2007


Kuo-Liang Peng
Primary Examiner
Art Unit 1712